



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,945	10/11/2001	Susheng Gan	50229-287	5823

20277 7590 12/28/2004  
MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

LY, CHEYNE D

ART UNIT	PAPER NUMBER
----------	--------------

1631

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/973,945

Applicant(s)

GAN ET AL.

Examiner

Cheyne D Ly

Art Unit

1631

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 2.

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE:

The claim amendments to claims 1 and 11, step b, and claim 6 introduce the new limitation of "the complement of SEQ ID NO:9" or "host cell comprising the replicable vector of claim 3", respectively, would require further consideration and/or search. The instant claim amendment has not been entered.

Continuation of 3. Applicant's reply has overcome the following rejection(s): 35 U.S.C. §102 as directed to claims 1-11.

Continuation of 5. does NOT place the application in condition for allowance because:

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is maintained with respect to claims 1-11, as recited in the previous office action mailed September 01, 2004.

#### RESPONSE TO ARGUMENT

Applicant's argument via claim amendment to claim 1, step (b), has been fully considered and found to be unpersuasive because of the non-entry of said claim amendment as discussed above.

Claims 6 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

This rejection is maintained with respect to claims 6 and 7, as recited in the previous office action mailed September 01, 2004.

#### RESPONSE TO ARGUMENT

Applicant's argument via claim amendment to claim 6 has been fully considered and found to be unpersuasive because of the non-entry of said claim amendment as discussed above.

Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.


This rejection is maintained with respect to claims 1-11, as recited in the previous office action mailed September 01, 2004.

#### RESPONSE TO ARGUMENT

Applicant argues that support of variants is disclosed on pages 5 and 22, Tables 1 and 3, wherein said tables provide a description of a representative number of species variants (pages 8-10). Applicant's argument has been found to be unpersuasive because full breadth of the claims 1-11 includes sequences that have not been disclosed as argued by Applicant. Specific to the exemplary sequences in Tables 1 and 3, the disclosure of the 33 sequences is hardly "a representative number of species variant" with respect to the possible number of variants from the sequence of SEQ ID NO. 9, or classification. For example, the SEQ ID NO:9 comprises 10 nucleotides, wherein each position could be an A, T, G, or C, therefore the possible variants from the SEQ ID NO:9 is 1,048,576 variants (4 to the 10<sup>th</sup>). Therefore, the disclosure of 33 variants in Tables 1 and 3 represents about 0.003% (33 divided by 1,048,576, multiply by 100) (less than 1 %). Further, the specification discloses the sequences are from the Arabidopsis genome which is not a "a representative number of species variant" by classification. Therefore, Applicant's argument that said tables provide a description of a representative number of species variants is not well supported.

Continuation of 10. Other: Specific to Applicant's argument directed to the withdrawal the non-elected subject matter claim 2, Applicant's argument of the other variants disclosed in claim 2 shares the common novel aspect of the elected invention has been fully considered and found to be unpersuasive. The sequences that are complements or variants of SEQ ID NO:9 could reasonably be construed as being patentably distinct from the sequence of SEQ ID NO:9. It is noted that only those sequences which are patentably indistinct from the selected sequences are examined together. Further, it is re-iterated that the sequence election requirement, mailed September 30, 2003, is a restriction and not a specie election requirement. Therefore, Applicant's request that the Examiner examine a reasonable number of nucleotide sequences has been denied. Therefore, the objection to claim 2 has been maintained.

The claim amendment is improper because the "(amended)" status identifier recited in claims 1, 6, and 11. Applicant is advised to review the MPEP §714 [R-2], (c) for proper status identifiers.

  
MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

12/22/2004